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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,380	11/20/2003	Derek A. Cogan	9/268	9526

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EXAMINER

SHIAO, REI TSANG

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/718,380	<b>Applicant(s)</b> COGAN ET AL.	
	<b>Examiner</b> Robert Shiao	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on responses filed on 12/07, 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/13/04, 4/14/04</u> | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

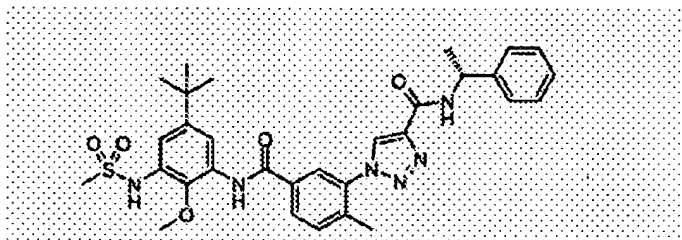
1. This application claims benefit of the provisional application: 60/430,519 with a filing date 11/27/2002.
2. Claims 1-13 are pending in the application.

### *Information Disclosure Statement*

3. Applicant's Information Disclosure Statements, filed on May 13, 2004 or April 14, 2004, have been considered. Please refer to Applicant's copy of the 1449 submitted herein.

### *Responses to Election/Restriction*

4. Applicant's election without traverse of Group III claims 1-9 and 13, in part, in the reply filed on December 07, 2005, is acknowledged. An elected compound as a single species, i.e.,



, is also acknowledged.

### *Status of the Claims*

5. Claims 1-13 are pending in the application. The scope of the invention of the elected subject matter is as follows.

Claims 1-9 and 13, in part, drawn to compounds/compositions of formula (I), wherein the variables R<sup>a</sup>, R<sup>b</sup>, R<sub>5</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>6</sub>, and Ar<sub>1</sub> independently does not

represents heteroaryl or heterocycle thereof, and the variables R<sup>a</sup>, R<sup>b</sup>, R<sub>5</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>6</sub>, or Ar<sub>1</sub> independently is not substituted with heteroaryl or heterocycle thereof.

Claims 1-9 and 13, in part, embraced in above elected subject matter, are prosecuted in the case. Claims 1-9 and 13, in part, not embraced in above elected subject matter, and claims 10-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made **FINAL**.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

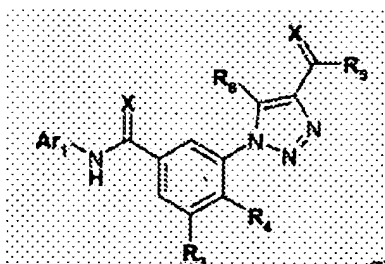
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-9 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 14 of Cogan et al. co-pending application No. 11/002,022, see US 2005/0153972 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other and reasons are as follows.

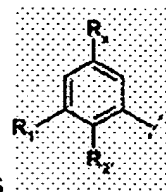
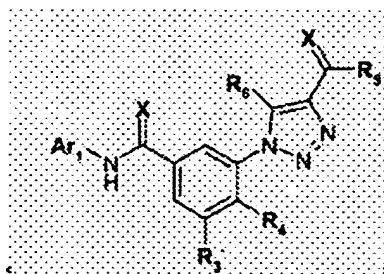
Applicants claim a compound/compositions of formula (I),



wherein the variable  $Ar_1$  represents carbocycle (i.e., phenyl), and optionally substituted with one  $R_1$ , and  $R_1$  represents hydrogen or  $NO_2$ , and independently substituted with two  $R_2$ , and  $R_2$  represents C1-6 alkyl; variables  $R_5$ ,  $R_3$ ,  $R_4$ , and  $R_6$  independently represent hydrogen or alkyl; and the variable  $X$  represents O or S. The instant compounds/composition are used as agents treating inflammation.

Cogan et al. '022 claims a compound/composition of formula (I),

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, wherein the variable Ar<sub>1</sub> represents

variables R<sub>1</sub>', R<sub>2</sub>', R<sub>x</sub>, R<sub>5</sub>, R<sub>3</sub>, R<sub>4</sub>, and R<sub>6</sub> independently represents hydrogen, C<sub>1-5</sub> alkyl; and the variable X represents O or S. Cogan et al. compounds/compositions are used as agents treating inflammation.

The difference between instant claims and Cogan et al. '022 is that the variable Ar<sub>1</sub> represents carbocycle, i.e., a cyclohexyl or phenyl moiety, while Cogan et al. represent a phenyl moiety at the same position.

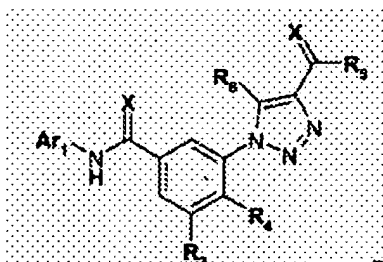
One having ordinary skill in the art would find the claims 1-9 and 13 *prima facie* obvious because one would be motivated to employ the compound/compositions of Cogan et al. to obtain instant claimed compounds/compositions of formula (I), wherein the variable Ar<sub>1</sub> represents carbocycle (i.e., phenyl) optionally substituted with one R<sub>1</sub>, and R<sub>1</sub> represents hydrogen or NO<sub>2</sub>, and independently substituted with two R<sub>2</sub>, and R<sub>2</sub> represents C1-6 alkyl; the variables R<sup>a</sup>, R<sup>b</sup>, R<sub>5</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>6</sub>, and Ar<sub>1</sub> independently does not represents heteroaryl or heterocycle thereof, and the variables R<sup>a</sup>, R<sup>b</sup>, R<sub>5</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>6</sub>, or Ar<sub>1</sub> independently is not substituted with heteroaryl or heterocycle thereof.

The motivation to make the claimed compounds/compositions derives from the expectation that the instant claimed compounds/compositions derived from known Cogan et al. compounds/compositions would possess similar activities (i.e., treating inflammation) to that which is claimed in the reference.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-9 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 11 of Cogan et al. co-pending application No. 111/120,735, see US 2005/0256113 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other and reasons are as follows.

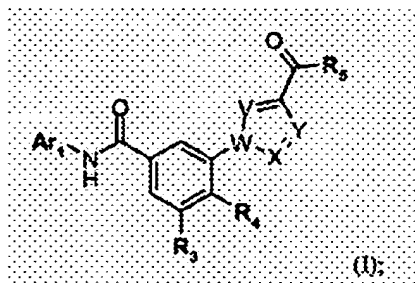
Applicants claim a 1,2,3-triazole compound/compositions of formula (I),



wherein the variable  $\text{Ar}_1$  represents carbocycle (i.e., phenyl), and optionally substituted with one  $\text{R}_1$ , and  $\text{R}_1$  represents hydrogen or  $\text{NO}_2$ , and independently substituted with two  $\text{R}_2$ , and  $\text{R}_2$  represents C1-6 alkyl; variables  $\text{R}_5$ ,  $\text{R}_3$ ,  $\text{R}_4$ , and  $\text{R}_6$  independently represent hydrogen or alkyl; and the variable  $\text{X}$  represents O or S. The instant compounds/composition are used as agents treating inflammation.


Cogan et al. '113 claims a 1,2,3-triazole compound/composition of formula (I),

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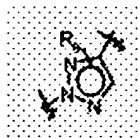


(I).

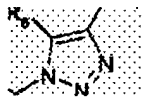
, wherein the variable  represents a 1,2,3-triazole

moiety, i.e., ; the variable Ar<sub>1</sub> represents a carbocycle substituted with R<sub>1</sub>, R<sub>2</sub>, and R<sub>x</sub>, and the variables R<sub>1</sub>, R<sub>2</sub>, R<sub>x</sub>, R<sub>5</sub>, R<sub>3</sub>, R<sub>4</sub>, and R<sub>6</sub> independently represents hydrogen or C<sub>1-5</sub> alkyl; and the variable X represents O or S. Cogan et al. compounds/compositions are used as agents treating inflammation.

The difference between instant claims and Cogan et al. '113 is that the variable



of Cogan et al. is a structure isomer of the instant 1,2,3-triazole moiety, i.e.,



, which is linked to the same phenyl moiety.

One having ordinary skill in the art would find the claims 1-9 and 13 *prima facie* obvious because one would be motivated to employ the compound/compositions of Cogan et al. to obtain instant claimed compounds/compositions of formula (I), wherein the variable Ar<sub>1</sub> represents carbocycle (i.e., phenyl) optionally substituted with one R<sub>1</sub>, and R<sub>1</sub> represents hydrogen or NO<sub>2</sub>, and independently substituted with two R<sub>2</sub>, and R<sub>2</sub> represents C<sub>1-6</sub> alkyl; the variables R<sup>a</sup>, R<sup>b</sup>, R<sub>5</sub>, R<sub>3</sub>, R<sub>4</sub>, R<sub>6</sub>, and Ar<sub>1</sub> independently does not represents heteroaryl or heterocycle thereof, and the variables R<sup>a</sup>, R<sup>b</sup>, R<sub>5</sub>, R<sub>3</sub>, R<sub>4</sub>,



R<sub>6</sub>, or Ar<sub>1</sub> independently is not substituted with heteroaryl or heterocycle thereof.

Nothing unobvious is seen in substituting the known claimed isomer of Cogan et al. '113 for the structurally similar isomer, since such structurally related compounds suggest one another and would be expected to share common properties (i.e., anti-inflammation activity) absent a showing of unexpected results, see *In re Norris*, 84 USPQ 458 (1950).

The motivation to make the claimed compounds/compositions derives from the expectation that the instant claimed compounds/compositions derived from known Cogan et al. compounds/compositions would possess similar activities (i.e., treating inflammation) to that which is claimed in the reference.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Objection***


9. Claims 1-9 and 13 are objected to as containing non-elected subject matter, i.e., heterocycle, heteroaryl, pyrrolidinyl, morpholinyl, piperazinyl, etc, see claims 1-9. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the page 2 *supra*.


### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

  
Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

January 27, 2006